

Please cancel claims 3, 5-9, 13, 15, 22-26 and 31 without prejudice or disclaimer.

Remarks

In view of the above amendments and the following remarks, favorable reconsideration of the outstanding office action is respectfully requested.

Attached hereto is a page entitled "Version of Markings to Show Changes Made."

Claims 1, 2, 4, 10-12, 14, 16-21, 27-30, 32-33, and 50-58 now remain in this application. Claim 1 has been amended. Claims 3, 5-9, 13, 15, 22-26 and 31 are canceled. Claims 34-49 have previously been withdrawn from consideration, without prejudice.

1. Information Disclosure Statements

Applicant's appreciate the acknowledgment of papers 10 and 11.

2. Drawings

The Examiner has indicated in the formal drawings previously submitted have not been received. Attached herewith is a letter to the draftsperson and (2) two sheets of formal drawings to replace the informal drawings originally submitted.

3. Specification

The Examiner acceptance of the new invention title is appreciated. Applicant's concur that the optical fiber itself drawn from the preform is excluded.

4. Claim Objections

The Examiner has objected to claim 1 because of the presence of [and] in line 3. This [and] is deleted and the objection should, therefore, be withdrawn.

Claims 3, 5-7, 15, 22-24 and 31 were intended to be cancelled in the previous office action response but such a request was inadvertently only included in the body of the office action. That cancellation is repeated herein. Also, Applicants wish to cancel claims 8-9, 13 and 25-26 without prejudice or disclaimer. Thus, Applicants wish to cancel claims 3, 5-9, 13, 15, 22-26 and 31 herein.



Claim Rejections -112

The Examiner has objected to claim 15 and 31 under 112, first para. Claims 15 and 31 have been deleted herein. As such, the rejection of claims 15 and 31 is moot.

6. § 103 Rejections

The Examiner has rejected claims 50 and 53 under 35 U.S.C. § 103(a) as being unpatentable for obviousness over Japanese Patent No. 02-258643 (Tsuji et al.) in view of US Patent No. 4,218,294 (Brack).

The Examiner asserts that Tsuji et al. teaches coating a silica-containing article used in the manufacture of optical fiber. Notably, Tsuji teaches a coating which is peeled off from the glass preform. Brack is directed towards release coatings. Release coatings are applied to the substrate and are not intended to be removed from the substrate. Release coatings function and are intended to allow other materials that are applied to the release coating to be easily and readily removed (released) from the release coating (for example, a mold release allowing a molded material to be readily released from a mold). Thus, Brack is directed to an entirely different problem, i.e., release coatings which is non-analogous art. One of ordinary skill in the art would not look to Brack to modify Tsuji, as the coating must be peelable in Tsuji for the Tsuji invention to function. Brack teach coatings that are securely adhered to the substrate. Thus, applying the teachings of Brack to Tsuji would destroy the operability of the Tsuji invention, in that the coating must be peelable. Destruction of the operability of the invention is one indicia of non-obviousness.

As such, the 103(a) rejection is respectfully traversed. Claims 51 and 52 are allowable for at least these reasons.

The Examiner has rejected claims 54-57 under 35 U.S.C. § 103(a) as being unpatentable for obviousness over Japanese Patent No. 02-258643 (Tsuji et al.) in view of US Patent No. 5,739,191 (Woodhall et al.).

Tsuji teaches a peelable polyvinyl system. Note that Tsuji does not teach the use of polyvinyl alcohol (a water soluble coating). Woodhall teaches a masking material readily removable with water or by peeling from a work surface to be painted or mechanically processed. Note that there is no suggestion in Woodhall to use a coating on an optical fiber article. Thus, there is no requisite suggestion in the art that the claimed process should be carried out, i.e., coating a silica-containing article used in the manufacture of optical fiber with a protective organic layer and then removing by washing during subsequent processing of the article. Further, Examiner should note that the coating in Woodhall is removed after

the mechanical process/painting (after the processing). Applicants herein, as claimed, remove the coating, and thus any adhered detrimental particles during further processing of the silica containing article. Thus, the claimed method subject matter, as a whole, is not suggested by the prior art. At best, Examiner has shown that it might be obvious to try the method taught in Woodhall on a silica-containing article used in the manufacture of optical fiber. However, it is well settled that "obvious to try" is not the standard of patentability. Accordingly, the obviousness rejection of claim 54 should be withdrawn. Claims 55-57 are allowable for at least these reasons.

7. Obviousness-Type Double Patenting

The Examiner states that claims 1-16, 18-32 and 50-58 are provisionally rejected as being unpatentable over claims 1-28 of co-pending application No. 09/569,562. In reviewing MPEP 804 1.B regarding obviousness-type double patenting rejections between two applications filed by a common assignee, the courts have sanctioned making the applicant aware of potential double patenting issues by allowing provisional double patenting rejections. This allows the party to address the merits of the rejection during the pendency of the applications. However, it seems in this case, that the appropriate action is to address the merits of the double patenting rejection only in the later filed case (09/569,562). Applicant's recognize that the Examiner should continue to make the rejection until the present case is in a condition for allowance (other than for the provisional double patenting issue) and then Examiner should withdraw the rejection and permit the present application to issue into a patent while converting the provisional rejection in the other case (the 09/569,562) into an actual double patenting rejection which then will be addressed in that later filed case. Note also, it is improper to reject, based upon obviousness, an earlier filed case based upon a later filed application. This is because any determination of obviousness must be made at the time of filing of the first case.

8. Conclusion

Based upon the above amendments, remarks, and papers of record, Applicant believes the pending claims of the above-captioned application are in allowable form and patentable over the prior art of record. Applicant respectfully requests reconsideration of the pending claims 1, 2, 4, 10-12, 14, 16-21, 27-30, 32-33, and 50-58 and a prompt Notice of Allowance thereon.



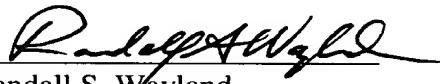
Applicant believes that no extension of time is necessary to make this Response timely. A petition for an extension of time is proved herewith. Should Applicant be in error, Applicant respectfully requests that the Office grant such time extension pursuant to 37 C.F.R. § 1.136(a) as necessary to make this Reply timely, and hereby authorizes the Office to charge any necessary fee or surcharge with respect to said time extension to the deposit account of the undersigned firm of attorneys, Deposit Account 03-3325.

Please direct any questions or comments to Randall S. Wayland at 607-974-0463.

Respectfully submitted,

CORNING INCORPORATED

Date: 11-26-02

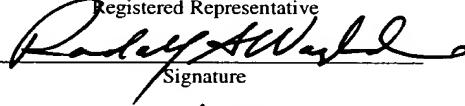

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VERSION OF MARKINGS TO SHOW CHANGES MADE

In the Claims

(Twice Amended) 1. A method of protecting a silica-containing article used in the manufacture of an optical fiber, the method comprising the steps of:

providing a silica-containing article used in the manufacture of an optical fiber;

[[and]]

applying a protective organic layer to the silica-containing article;

removing, by cleaning, particulates from the protective layer; and

ablating the protective layer by heating during subsequent processing of the silica-containing article.

Please cancel claims 3, 5-9, 13, 15, and 22-26 and 31.